

REMARKS/ARGUMENTS

The amendment to Claim 1 is supported by original Claims 1, 10 and 17. No new matter has been entered.

As noted by the above amendment, the limitations of original Claims 10 and 17 have been incorporated into pending Claim 1, thereby specifying the presence of a monoether compound represented by formula (II) and a condensate product from a polyethyleneimine and a fatty acid. In addition, friction modifier (C) in amended Claim 1 has been limited to an amine salt of a phosphate ester.

No rejection of record includes both Claims 10 and 17. Claim 10 is rejected in paragraph 7 at page 8 of the outstanding Official Action, but this rejection does not include the combination of references applied against Claim 17. Claim 17 was separately rejected in paragraph 8 at page 8 of the Official Action, but over a different combination of references used to reject Claim 10. Moreover, and with regard to the limitation of friction modifier (C) to an amine salt of a phosphate ester, this limitation, in combination with the other limitations incorporated into pending Claim 1 from Claims 10 and 17, defines a unique, patentable conductive lubricant composition comprising an ether compound of present formula (II), a condensate product from a polyethyleneimine and a fatty acid, and an amine salt of a phosphate ester. Even if one were to combine all the references applied against the pending claims herein one would not reasonably arrive at Applicants' presently claimed conductive lubricant composition.

In addition, and as pointed out in Applicants' last response, the presently claimed conductive lubricant composition provides several excellent functional properties that are nowhere disclosed or suggested by the prior art, including excellent volume resistivity. In this regard, present Examples 9, 11 and 12 in Table 3-2 at specification page 29 show

excellent volume resistivity values when friction modifier A, an amine salt of a phosphate ester, (see Table 2 at specification page 27) is used:

TABLE 3-2

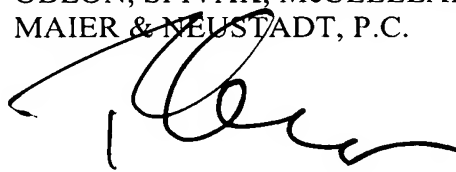
Lubricant composition (parts by mass)	Ex. 7	Ex. 8	Ex. 9	Ex. 10	Ex. 11	Ex. 12
Base oil A-1						
Base oil A-2	68.8	68.8	97.75		67.7	67.75
Base oil A-3						
Base oil B	30			98.75	30	
Base oil C						
Base oil D		30				30
Base oil E						
Anti-oxidant	1	1	1	1	1	1
Rust preventive			1		1	1
Friction modifier A			0.05		0.05	0.05
Friction modifier B				0.05	0.05	
Antistatic agent A						
Antistatic agent B						
Antistatic agent C	0.2	0.2	0.2	0.2	0.2	0.2
(Total)	100	100	100	100	100	100
Kinematic viscosity (mm ² /s) at 40° C.	8.58	8.71	8.851	9.009	8.49	8.95
Viscosity index	131	112	123	132	131	112
Flash point (COC method) (° C.)	214	205	204	210	211	204
Pour point (° C.)	-45	-45	-50	-40	-45	-45
Volume resistivity (×10 ¹⁰ Ω · cm)	0.15	0.27	0.0135	0.36	0.0122	0.014
Thin film residue test (80° C., 500 hr)						
Percent oil retention (mass %)	95.2	91.44	94.97	94.06	94.83	91.27
Appearance (sludge)	No	No	No	No	No	No

As shown in the above Table, these volume resistivity values are substantially lower than anything obtained even with a composition closer to the presently claimed invention than anything disclosed or suggested by the prior art – compare Example 10, using a polysulfide friction modifier, with Examples 9, 11 and 12, using the presently claimed amine salt of a phosphate ester friction modifier. As nothing in even the combination of references applied herein discloses or suggests such a beneficial effect, these results clearly are unexpected vis-à-vis the applied references, and further supportive of patentability herein, particularly in view of the substantial amendments to Claim 1 above.

Accordingly, and in view of the differences between what is disclosed and suggested by the references of record herein, and in view of the surprisingly beneficial results obtained with Applicants' narrowly claimed conductive lubricant composition, Applicants respectfully request the reconsideration and withdrawal of the outstanding rejections, and the passage of this case to Issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)